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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,856	03/30/2001	David W. Cannell	05725.0877-00	7050

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EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary***File copy*

Application No.

09/820,856

Applicant(s)

CANNELL ET AL.

Examiner

JYOTHSNA A VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-216 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-216 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other:  |

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### **DETAILED ACTION**

Receipt is acknowledged of extension of time, and election filed on 11/5/02 and IDS filed on 3/30/01.

Claims 1-216 are pending in the application and the status of the application is as follows:

Upon further review of the claims the restriction between all the groups is rescinded and all the claims are examined on the merits.

#### ***Specification***

1. The attempt to incorporate subject matter into this application by reference to WO document 01/18-96 at page 10 and CFTA cosmetic Ingredient dictionary at page 11 is improper because applicants are relying on these documents for one of the ingredient which is part of the essential subject matter. Applicants are relying on for “ film forming agent”.

#### ***Information Disclosure Statement***

1. The information disclosure statement filed 3/30/01 with respect to the document numbers 12-14 cited on PTO-1449 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

2. Clarification is requested for the documents 18-19 cited on PTO-1449. The documents are identified as “ literature search performed by Assignee”. There is no search query and the

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examiner is unable to determine the scope of search results. The foreign documents have been considered to the extent that it reads on the abstract only.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-216 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

✓ 1. The expression “*C<sub>3</sub>-C<sub>5</sub> monosaccharides substituted with at least one C<sub>1</sub>-C<sub>22</sub> carbon chain*” is unclear as to applicant’s intent. The specification at pages 16-17 defines the meaning of “substituted”. The examiner is unclear with respect to “*substituted with the carbon chain*” when the carbon chain is *cyclic*. The simplest cyclic member is cyclopropane. Additionally the examiner requests applicants to ***provide examples*** when the substituted is cyclic chain and when the cyclic chain is substituted at the oxygen atom of the saccharide and also at the carbon atom of the saccharide.

X 2. The expression “*oxidized derivatives of C<sub>3</sub>-C<sub>5</sub> monosaccharides*” for claims 26, 85, 135 and 182 is without metes and bounds. The specification at page 15, line 21 does not describe the compounds under this category.

X 3. Claims 27, 86, 136 and 183 lacks antecedent basis. How can the oligosaccharide derive form monosaccharides? Detailed explanation is requested.

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✓ 4. The expression “ wherein said derivatives of *C<sub>3</sub>-C<sub>5</sub> monosaccharides are further substituted with at least one group different from said at least C<sub>1</sub>-C<sub>22</sub> carbon chain for claims 29, 88, 138 and 185*” is without metes and bounds. A careful review of the specification does not define suitable substituents in this category.

5. The expression “*at least one of C<sub>1</sub>-C<sub>22</sub> carbon chain is substituted for claims 31, 140 and 187*” is without metes and bounds. A careful review of the specification does not define suitable substituents in this category.

✓ 6. Claims 36, 95, 145 and 192 are ambiguous. The claims would better read by amending to “ wherein the *C<sub>3</sub>-C<sub>5</sub> monosaccharides is substituted with said at least C<sub>1</sub>-C<sub>22</sub> carbon chain at the CH<sub>2</sub> position of the C<sub>3</sub>-C<sub>5</sub> monosaccharides*”.

7. Claim 205 lacks antecedent basis. The claim would read better by amending “ 203 “ to “ **204**”.

8. Claims 19, 22-23, 78, 81-82, 128, 130-131, 175 and 178-179 are indefinite because there is only one compound and the expression “ chosen from “ is used for Markush group. Amending “ are chosen from “ to “ is” is suggested to overcome the above rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-15, 30, 38-40, 53-74, 89, 97-100, 110-124, 139, 147-150, 160-171, 186, 194-197 and 207-216 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Harry's Cosmeticology by Ralph Harry pp 470-483 (1982), U. S Patent 6,235,298 ('298) and U. S. Patent 5,688, 930 ('930).

The instant application is claiming composition and method for durable non-permanent shaping of at least one keratinous fiber or durable retention of non-permanent shape of at least one keratinous fiber comprising:

1. *At least one film-forming agent*
2. *At least one compound chosen from C<sub>3</sub>-C<sub>5</sub> monosaccharides substituted with at least one C<sub>1</sub>-C<sub>22</sub> carbon chain where in the monosaccharides is pentoses*
3. *Additional saccharide which is polysaccharide*
4. *Additives*

Harry's cosmeticology teaches component 1 and component 4. See pages 475-478 for the various resins which is also claimed by applicants as the film-forming agent. See also the examples in the cited pages for the various additives. The Cosmeticology does not teach the specific Polyquaternium claimed in the instant application. Patent '298 teaches polyquaternium claimed in the instant application as the film-forming agent along with components 3-4. See col.7, line 35 for the hair fixative former or film former along with various film formers claimed

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in the instant application. The patent also teaches polysaccharides as the amphoteric surfactant. See col.18, lines 45 et seq. See also the examples. The only difference between these two documents is both the documents do not disclose ingredient 2. However the patent '930 teaches ingredient 2 as the surfactant. See the abstract, See col.3, lines 33 et seq where the compounds taught are the pentoses substituted with alkyl chains. See also col.4, col.6, lines 10 et seq and see the examples and see specially examples 33-36.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of 'Harry's Cosmetology and Patent '298 and combine it with the *substituted* saccharides of '930, expecting beneficial effect to the hair. The motivation to use the *substituted* saccharides stems from the teachings of '930 that the compositions provide emulsifying, foaming and wetting and dispersant properties. This is a prima facie case of obviousness.

The test results in the specification are not commensurate with the scope of the claims.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-55, and 167-216 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101, 103-105, 115, 121, 123-127, 129-131, 142-152, 161, 166, 168-172, 174-177, 187-204 of copending Application No.

09/820,812. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the co-pending application are claiming the compositions with the following ingredients which are *At least one compound chosen from C<sub>3</sub>-C<sub>5</sub> monosaccharides substituted with at least one C<sub>1</sub>-C<sub>22</sub> carbon chain where in the monosaccharides is pentoses*

2. *Additional saccharide which is polysaccharide*

3. *Additives*

The scope of claims 167-216 is the same as the instant application and the expression comprising in the co-pending application is inclusive of the film-forming agent claimed in claims 1-55.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-55, and 167-216 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 13-19 and 29-59 of copending Application No. 09/820,934. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the co-pending application are claiming the compositions with the following ingredients which are *At least one compound chosen from C<sub>3</sub>-C<sub>5</sub> monosaccharides substituted with at least one C<sub>1</sub>-C<sub>22</sub> carbon chain where in the monosaccharides is pentoses*



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*2. Additional saccharide which is polysachharide*

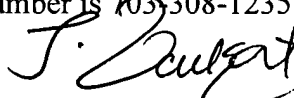
*3. Additives and film forming agent. There is overlap with the film-forming agent in both the application with respect to polyquaternium.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
JYOTHSNA A VENKAT  
Primary Examiner  
Art Unit 1615

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January 27, 2003